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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/649,252
Filing Date: August 26, 2003
Appellant(s): JOHNSON ET AL.

Bart A. Fisher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 10, 2008 appealing from the Office action mailed February 6, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

ChoicePoint, 2002-01-24,
[online], Retrieved from
web.archive.org using the
Internet <URL:
<http://web.archive.org/web/20020124085629/http://www.choicepoint.net/>>

2002/0055862	Jinks	05-2002
2001/0023404	Ogawa	09-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184

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(1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

2. Claims 1-21 recite a "method for establishing a rate quote" which fails to (1) be tied to another statutory class and (2) transform underlying subject matter. Although claim 14 recites a "computer system" method, this is just a nominal recitation of a physical structure and fails to satisfy the statutory requirements. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Furthermore, no transformation of any physical object is completed during the recitation of the present invention. As such, the present invention is directed towards non-statutory subject matter and is rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 14, 16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jinks, et al., hereinafter Jinks. (U.S. Patent Application Publication No. 2002/0055862) in view of Ogawa, et al. (U.S. Patent Application Publication No. 2001/0023404).

5. (Currently Amended) As per claim 1, Jinks teaches a method for establishing rates for a property insurance policy, the method comprising:

determining a single tier placement for an applicant dependent upon a combination of mutually exclusive factors based on a plurality of data about the applicant, such that no single risk characteristic is the sole determinant for placement in a tier (page 1, para. 2), the factors including:

- a) a protection class, (page 1, para. 2); and
- b) a previous paid loss history, (page 4, para. 26); and

Jinks does not teach establishing a rate quote for a property insurance policy of a single insurance company for the applicant based on the tier placement of the applicant, wherein the tier placement results in one of a preferred rate quote, a standard rate quote, and a non-standard rate quote. However, Ogawa teaches establishing a rate quote for a property insurance policy for the applicant based on the tier placement of the applicant, wherein the tier placement results in one of a preferred rate quote, a standard rate quote, and a non-standard rate quote, (page 1, para. 5, and page 2, para. 35).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine Jinks and Ogawa's teachings with the motivation of providing premium estimates from a plurality of insurance providers based on inputting conditions which affect the premium calculation (Ogawa, abstract).

6. (Original) As per claim 2, Jinks teaches the method of claim 1 as described above. Jinks further teaches the following:

wherein the policy is a renewal policy, (page 3, para. 23).

7. (Original) Regarding claim 3, Jinks teaches the method of claims 1 and 2 as described above. Jinks further teaches the following:

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wherein the protection class is one of a plurality of nationally published numbers, (page 3, para. 24).

8. (Original) Regarding claim 4, Jinks teaches the method of claim 1-3 as described above. Jinks further teaches the following:

the nationally published numbers are in a range of from 1 to 10. (page 3, para. 24).

9. (Original) Regarding claim 5, Jinks teaches the method of claims 1-2 as described above. Jinks further teaches the following:

the previous paid loss history establishes one number in a range of from 0 losses to 3 or more losses paid in a previous three year period., (page 4, para. 26).

10. (Original) Regarding claim 6, Jinks teaches the method of claim 1 as described above. Jinks further teaches the following:

wherein the previous paid loss history is established based on one or more of information provided by an applicant, information provided by an insurer, and information provided by a third party, (pages 4-5, paragraphs 33-34).

11. (Currently Amended) As per claim 14, Jinks teaches following:

A system for establishing rates for a property insurance policy, the system comprising:

a computer system for determining a single tier placement for an applicant dependent upon a combination of mutually exclusive factors based on a plurality of data about the applicant, (page 1, para. 2), the computer system including:

a storage device storing a program, (claim 10); and

a processor coupled to the storage device, (page 1, para. 6), the processor operative with the program for establishing a rate quote for a property insurance policy of a single insurance company for the applicant based on the tier placement of the applicant in response to determining a protection class factor and a previous paid loss history factor, (claim 10), wherein the tier placement results in one of a preferred rate quote, a standard rate quote, and a non-standard rate quote. processing the insurance information in accordance with the respective underwriting rules to determine whether a premium quotation may be issued for each of the two or more insurance carriers. Jinks does not teach wherein the tier placement results in one of a preferred rate quote, a standard rate quote, and a non-standard rate quote. processing the insurance information in accordance with the respective underwriting rules to determine whether a premium quotation may be issued for each of the two or more insurance carriers. However, Ogawa teaches wherein the tier placement results in one of a preferred rate quote, a standard rate quote, and a non-standard rate quote. processing the insurance information in accordance with the respective underwriting rules to determine whether a premium quotation may be issued for each of the two or more insurance carriers, (page 1, para. 5, and page 2, para. 35).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine Jinks and Ogawa's teachings with the motivation of providing premium estimates from a plurality of insurance providers based on inputting conditions which affect the premium calculation (Ogawa, abstract).

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12. (Original) Regarding claim 16, Jinks teaches the method of claim 14 as described above. Jinks further teaches the following:

wherein the policy is a renewal policy, (page 3, para. 23).

13. (Currently Amended) As per claim 18, Jinks teaches the following:

A method for establishing rates for a property insurance policy ~~for a member of a membership organization~~, the method comprising:

an applicant communicating a request for property insurance, (abstract);

in response to the request, using a computer system for determining a single tier placement for the applicant dependent upon a combination of mutually exclusive factors based on a plurality of data provided by the applicant, (page 1, para. 2), the factors including:

a) a protection class, (page 1, para. 2); and

b) a previous paid loss history, (page 4, para. 26); and

Jinks does not teach establishing a rate quote for a property insurance policy of a single membership organization for the applicant based on the tier placement of the applicant, wherein the tier placement results in one of a preferred rate quote, a standard rate quote, and a non-standard rate quote. However, Ogawa teaches establishing a rate quote for a property insurance policy for the applicant based on the tier placement of the applicant, wherein the tier placement results in one of a preferred rate quote, a standard rate quote, and a non-standard rate quote, (page 2, para. 35). Ogawa does not teach of a single membership organization. However, Jinks teaches insurance

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being offered to business owners, (page 1, para. 2). Examiner interprets a 'group of business owners' to encompass 'a single membership organization'.

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine Jinks and Ogawa's teachings with the motivation of providing premium estimates from a plurality of insurance providers based on inputting conditions which affect the premium calculation (Ogawa, abstract).

14. (Original) As per claim 19, Jinks teaches the method of claim 18 as described above. Jinks further teaches the following:

wherein the policy is a renewal policy, (page 3, para. 23).

15. Claims 7-13, 15, 17, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jinks, et al. (U.S. Patent Application Publication Number US 2002/0055862) in view of Ogawa, et al. (U.S. Patent Application Publication No. 2002/0055862) and further in view of ChoicePoint, 2002-01-24, [online], Retrieved from web.archive.org using the Internet <URL: <http://web.archive.org/web/20020124085629/http://www.choicepoint.net/>>. (Hereinafter ChoicePoint).

16. (Previously Presented) As per claim 7, the method of claim 1 is taught as described above. Jinks does not teach wherein the factors for determining a single tier placement for the applicant further comprise an insurance credit score. However, ChoicePoint teaches determining an insurance credit score, (Insurance Information Services, page 1).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine Jinks and Choicepoint's teachings with the motivation to determine an insurance credit score for the purposes of secure risk management. (ChoicePoint Insurance Information page 1).

17. (Original) Regarding claim 8, Jinks in view of ChoicePoint teaches the method of claim 7 as described above. Jinks further teaches the method wherein the policy is a new policy, (page 3, para. 24).

18. (Original) Regarding claim 9, Jinks in view of ChoicePoint teaches the method of claim 7 as described above. Jinks does not teach wherein the insurance credit score is derived from a nationally used credit model. However, ChoicePoint teaches wherein the insurance credit score is derived from a nationally used credit model, (Insurance Information Services, page 1). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate determining an insurance credit score into the method taught by Jinks. One of ordinary skill in the art would have been motivated to incorporate this method into Jinks and determine an insurance credit score for the purposes of secure risk management. (ChoicePoint Insurance Information page 1).

19. (Original) Regarding claim 10, Jinks in view of ChoicePoint teaches the method of claim 9 described above. Jinks does not teach wherein the insurance credit score is a three digit number which falls into one of a set of multiple ranges. However, ChoicePoint teaches wherein the insurance credit score the insurance credit score is a three digit number which falls into one of a set of multiple ranges, (Insurance

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Information Services, page 1). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate determining an insurance credit score into the method taught by Jinks. One of ordinary skill in the art would have been motivated to incorporate this method into Jinks and determine an insurance credit score for the purposes of secure risk management. (ChoicePoint Insurance Information page 1).

20. (Original) Regarding claim 11, Jinks in view of ChoicePoint teaches the method of claim 7 as described above. Jinks further teaches the method wherein the protection class is one of a plurality of nationally published numbers, (page 3, para. 24). Examiner interprets 'standard ISO classifications' to encompass a plurality of nationally published numbers.

21. (Original) Regarding claim 12, Jinks in view of ChoicePoint teaches the method of claim 11 as described above. Jinks further teaches the method wherein the nationally published numbers are in a range of from 1 to 10. (page 3, para. 24). The instant application states, "The protection class factor at 104 includes an assigned number of from 1 (best) to 10 (worst). This number is provided by The Insurance Services Organization (ISO) on a nationally available rating table".

22. (Original) Regarding claim 13, Jinks in view of ChoicePoint teaches the method of claim 7 as described above. Jinks further teaches the method wherein the previous paid loss history establishes one number in a range of from 0 losses to 3 or more losses paid in a previous three year period., (page 4, para. 26).

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23. (Previously Presented) Regarding claim 15, the method of claim 14 is taught as described above. Jinks does not teach wherein the processor is operative with the program to establish a rate quote for a the property insurance policy for the applicant based on the tier placement of the applicant in response to further determining an insurance credit score factor. However, ChoicePoint teaches wherein the processor is operative with the program to establish a rate quote for a property insurance policy for the applicant based on the tier placement of the applicant in response to further determining an insurance credit score factor, (Insurance Information Services, page 1).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine Jinks and Choicepoint's teachings with the motivation to determine an insurance credit score for the purposes of secure risk management. (ChoicePoint Insurance Information page 1).

24. (Original) Regarding claim 17, Jinks in view of ChoicePoint teaches the method of claim 15 as described above. Jinks further teaches the method wherein the policy is a new policy, (page 3, para. 24).

25. (Previously Presented) As per claim 20, the method of claim 18 is taught as described above. Jinks does not teach wherein the factors used for determining a single tier placement for the applicant further include an insurance credit score. However, ChoicePoint teaches wherein the factors used for determining a single tier placement for the applicant further include an insurance credit score, (Insurance Information Services, page 1).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine Jinks and Choicepoint's teachings with the motivation to determine an insurance credit score for the purposes of secure risk management. (ChoicePoint Insurance Information page 1).

26. (Original) Regarding claim 21, Jinks in view of ChoicePoint teaches the method of claim 20 as described above. Jinks further teaches the method wherein the policy is a new policy, (page 3, para. 24).

(10) Response to Argument

In the appeal brief filed September 30, 2008, Appellant makes the following arguments.

(A) Appellant asserts that there is not suggestion or motivation to combine the references. However, the Examiner cited a motivation to combine the references in the rejections above and in previous office actions. Further, the fact that Jinks is concerned, as asserted by the appellant, with insuring a business risk, and that Ogawa is concerned, as asserted by the appellant, with providing an insurance premium or rate quote from each of a plurality of companies does not mean that modifying Jinks to include features of Ogawa would destroy Jinks functionality. In fact, it is common in insurance environments for systems and methods to be expanded from one environment to another. In addition, Jinks and Ogawa are in the same field of endeavor of insurance, and the combination is thus proper.

(B) Appellant further asserts that Jinks, Ogawa, Choicepoint, or any combination thereof does not teach "establishing a rate quote for a property insurance policy of a

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single insurance company". In response, the Examiner respectfully disagrees. It is readily apparent that Ogawa suggests "establishing a rate quote for a property insurance policy of a single insurance company", (See Ogawa, page 1, para. 5).

(C) Appellant further argues that Jinks, Ogawa, Choicepoint, or any combination thereof does not teach "establishing a rate quote for a property insurance policy of a single membership organization". In response, the Examiner respectfully disagrees. It is readily apparent that Jinks suggests "establishing a rate quote for a property insurance policy of a single membership organization", (See Jinks, page 1, para. 2).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Amber L. Altschul/

Examiner, Art Unit 3626

Amber L. Altschul

A handwritten signature in black ink, appearing to read 'Gerald J. O'Connor', with a stylized, cursive script.

Gerald J. O'Connor

Supervisory Patent Examiner, Art Unit 3686

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Vincent Millin

Appeals Practice Specialist

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

Gerald J. O'Connor



Supervisory Patent Examiner, Art Unit 3686

Vincent Millin

Appeals Practice Specialist



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Wynn W. Coggins

Director, TC 3600



WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR

